

*preferably omits, what is well known in the art. In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991)." (emphasis added)

The applicant respectfully maintains that one of ordinary skill in the art can make the claimed invention, including providing a more prominent display of the current high-scoring player in a particular session of a game, based on the applicant's disclosure and information known in the art, without undue experimentation. The applicant teaches the prominent display of the current high-scoring player, and omits teaching the display of other players. As noted by the cited prior art, the display of other players is well known in the art. The applicant's specification does not prevent or preclude the display of other players, and the applicant's FIG. 2 clearly shows a prominent display of the image of the high scoring player 72. One of ordinary skill in the art would have no difficulty in making or using the invention as claimed with reference to FIG. 2, and no experimentation would be required.

The Office action notes that the images 72 and 74 of FIG. 2 are substantially equally prominent, and thus teach away from this claim. The applicant respectfully notes, however, that image 74 does not, per se, represent a player of the current session of the game. Image 74 represents a past player who holds the record in the displayed game. There is no suggestion in the applicant's specification that the image 74 corresponds to another player in the particular session of the video game, as claimed, and the applicant's claim make no reference to the prominence of the high-scoring player 72 relative to a record-holding player 74.

The Office action includes a rejection of claims 1-4 and 6-8 under 35 U.S.C. 103(a) over Sitrick and Breslow. The applicant respectfully traverses this rejection.

The Office action fails to fully address the claims, citing instead the above rejection under 35 U.S.C. 112, first paragraph, as the rationale for not addressing the added limitations that distinguish these claims from the prior art. The Examiner's attention is requested to MPEP2143.03, which states that "All Claim Limitations Must Be Taught or Suggested", including indefinite limitations, limitations that do not find support in the original specification, and so on.

RECEIVED  
CENTRAL FAX CENTER  
SEP 29 2003

The Office action also asserts that "claims 2-4 and 7-9 stand or fall therewith, this rejection stands for these claims as well". The applicant respectfully notes that the "stand or fall therewith" clause is only applicable for the convenience of the Board of Appeals. The applicant is entitled to a complete examination of each claim on its merits.

The Office action also states: "regarding newly added claims 10-14 ... The only new feature of the instant claims that *has not been addressed* by the examiner is found in lines 9-11 of the claim [10]", again referring to the more prominent display of the high-scoring player.

The applicant respectfully requests a new Office action, fully addressing each element of each claim in view of the prior art, so that the claims can be found to be allowable, or so that an appropriate response can be filed in this application.

In view of the foregoing, the applicant respectfully requests that the Examiner withdraw the rejections of record, allow all the pending claims, and find the present application to be in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,



Robert M. McDermott, Esq.

Reg. No. 41,508

804-493-0707

**CERTIFICATE OF MAILING OR TRANSMISSION**

It is hereby certified that, on the date shown below, this correspondence is being:

☐ deposited with the United States Postal Service with sufficient postage as first-class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

☒ transmitted by facsimile to the United States Patent and Trademark Office at 703-872-9302.

On 27 September 2003

By

